

Amendments to the Drawings:

The attached 4 sheets of drawings include changes to Figs. 3-6. These sheets, which include Figs. 3-6, replace the original sheets including Figs. 3-6. In Figure 3, the erroneous reference to Fig. 3 has been replaced with a reference to Fig. 4. In Figure 4, the erroneous reference back to Fig. 2 has been corrected to refer back to Fig. 3. In Figure 5, the erroneous reference to Fig. 5 has been corrected to refer to Fig. 6, and in Figure 6, the erroneous reference back to Fig. 4 has been corrected to refer back to Fig. 5.

Attachments: Replacement Sheets, Annotated Sheets Showing Changes.

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-33 remain in this application. New claim 34 has been added without adding any new matter.

Figures 3-6 have been amended as follows: In Figure 3, the erroneous reference to Fig. 3 has been replaced with a reference to Fig. 4. In Figure 4, the erroneous reference back to Fig. 2 has been corrected to refer back to Fig. 3. In Figure 5, the erroneous reference to Fig. 5 has been corrected to refer to Fig. 6, and in Figure 6, the erroneous reference back to Fig. 4 has been corrected to refer back to Fig. 5. It was clear from the originally filed drawings that these references were incorrect and the correct references are clear from the context of the drawings and the specification.

Claims 1-11 and 14-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kraftson et al. (U.S. 6,151,581) in view of Joao (U.S. 6,283,761), and in view of Siegrist, Jr. *et al.* (U.S. 5,652,842). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites a survey system that has been amended to include the feature that

said system generates analyzed feedback for display to each survey participant utilizing historical survey data, said displayed analyzed feedback formatted in a custom manner based on whether the current survey participant is a customer, an employee, or a manager

None of the references teach or suggest that historical survey data is used to generate analyzed feedback for display to the survey participant, where the material is formatted in a custom manner based on whether the participant is a customer, employee, or a manager. Thus, claim 1 is patentable over the references. Amended claims 14, 29, and 30, and new claim 31 also include limitations that are similar (but perhaps of a different scope) to those cited above for claim 1, and thus they are also patentable over the references, as are claims 2-11, and 15-28, which depend, directly or indirectly, upon one of claims 1 and 14.

Furthermore, the Examiner argues that “non-functional descriptive material” will not distinguish the claimed invention, citing *In re Nagi* 367 F.3d 1336, 1339, 70 USPQ2d 1962, 1864 (Fed. Cir. 2004) and *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). This is not a proper rejection. The Examiner argues that “nonfunctional descriptive material” are features that cannot alter how a machine functions (i.e., does not reconfigure the computer). The Examiner argues that “practice data, historical performance data, pathophysiologic normative data, etc.) will not distinguish the claimed invention from the prior art in terms of patentability.

The Examiner ignores the fact that such data does, indeed, alter how a computer using the routines of the invention functions. For example, the claims require that the survey data be analyzed to provide these specific types of data, which are then used to generate the reports that are provided to users of the systems. Obviously, specific routines must be programmed into any computer in order to analyze survey data to provide such data, and thus this data rejected by the Examiner as being merely “descriptive” clearly is *not* merely descriptive, but requires that the computer perform functions in order to support it. A computer cannot categorize such data without specific instructions as to how to do so. Thus, these rejections on these grounds are not proper.

Finally, as discussed below, the Examiner has not provided the proper motivation for supporting a *prima facie* case of obviousness, and thus the rejections are not proper for this reason as well.

Claims 12-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kraftson, Joao, and Siegrist, in further view of Plantec *et al.* (U.S. 6,826,540). For the following reasons, the rejection is respectfully traversed.

Applicant notes that claim 12 is a claim having extensive limitations as to how the survey system operates, and yet the Examiner has rejected this claim without any detail as to how the various limitations of the claim are taught by the prior art. The MPEP requires that the prior art references must teach or suggest *all* of the claim elements and/or claim limitations (MPEP §2143.03) and that the Examiner must identify his rejections with reasonable specificity. The Examiner has failed to identify any of the rejections with reasonable specificity, as required. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). A statement of a rejection

that includes a large number of rejections must explain with reasonable *specificity* at least one rejection, otherwise the examiner procedurally fails to establish a prima facie case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989). See also MPEP 2142.

In essence, claim 12 recites many different features that have not been shown to be known to the prior art. For example, claim 12 recites a “panel membership program for providing a panel membership survey script...for inviting the patient to join a panel”, which applicant could not find in any cited reference. Furthermore, the claim recites a whole series of comparative patient level data, job performance data, and fiscal performance data, and the feature of providing various formatted survey information, that have not been shown to be part of any automated survey system. As discussed above, such data collection, analysis, formatting, and display is clearly not merely “non-functional descriptive material” as that term is used in the cited caselaw, as dealing with such data clearly requires computer functionality to handle it in the manner specified by the claim.

Accordingly, claim 12, and claim 13 which depends on claim 12, are patentable over the references.

Finally, the Examiner has not provided the proper motivation for combining the references, and thus has not made a prima facie case of obviousness. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. Instead, the Examiner merely cites very generalized “benefits” for making the combination, benefits such as “improving the quality of products or services rendered” or for “automating the collection of survey data”. These are not

motivations for making the specific modifications recommended by the Examiner, but merely general motivations that could be applied to *any* improvement of the cited art.

Clearly, merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

Accordingly, the rejections for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33035US1.

Respectfully submitted,

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